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In re Application of
KO et al.
Serial No.: 10/572,563
PCT No.: PCT/CN04/01044
Int. Filing Date: 14 September 2004
Priority Date: 17 September 2003
Atty Docket No.: 8964-000031/US
For: A FUNGAL IMMUNOMODULATORY
PROTEIN PRODUCED BY MICROORGANISMS
AND USES THEREOF

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(a)" filed 02 April 2007 to accept the application without the signatures of joint inventors, HSU-WEI HUNG, HO-LUNG JIANG, CHING-LING HU AND CHENG-CHUN KUAN. Applicant also requests a four month extension of time, which is granted.

BACKGROUND

On 02 April 2007, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors HSU-WEI HUNG, HO-LUNG JIANG, CHING-LING HU AND CHENG-CHUN KUAN.

On 24 August 2007, a decision dismissing the petition was mailed to applicant.

On 22 February 2008, a renewed petition was filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1) and (3) above were previously satisfied.

Regarding item (2) above, Petitioner contends that HSU-WEI HUNG, HO-LUNG JIANG, CHING-LING HU AND CHENG-CHUN KUAN have refused to sign the application.

Specifically, applicant submitted the declaration of Tzu-Chih Chen, who states that a copy of the application along with declaration and assignment was mailed to the nonsigning inventors at their last known address.

The declaration of David Ko was also submitted in support of the 37 CFR 1.47(a) petition. The declaration indicates that "On Dec. 3, 2007, I sent the patent specification including claims along with formal documents to each of the nonsigning inventors at their last known mailing address." (¶ 7). Ko's declaration further indicates that declaration documents from Ho-Lung Jiang were received.

Declarant Ko states that when he contacted them, inventors Hung, Kuan and Hu refused to sign the declaration. The details of their refusal are set forth in an accompanying telephone "Phone Record" which included the date and time of the telephone contact and the non-signing inventors' refusal.

Applicant has now presented sufficient evidence to show that (1) Messrs. Hung, Hu and Kuan were presented with and received a complete copy of the application papers including a declaration and (2) they refuse to sign the application papers. In light of the above, Item (2) above is now satisfied.

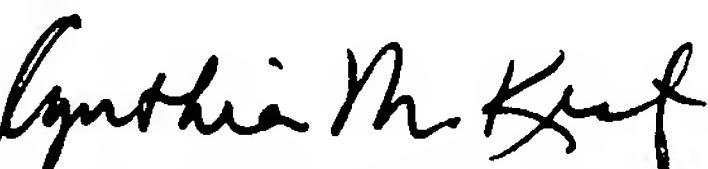
However, with regard to Item (4) and inventor HO-LUNG JIANG's incomplete declaration, Petitioner presented only the signatory sheet (Page 7) with inventor's Jiang's signature upon it. This declaration is not properly executed. It appears that the inventor was presented with an incomplete declaration. While it is acceptable for an applicant to execute a separate copy of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. The declaration is unacceptable as filed and thus, the requirements of 37 CFR 1.497 (a) and (b) have not been met. It is appropriate to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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